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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,722	05/29/2001	Grant W. Doney	3343.14	5947

7590

08/14/2002

GRANT DONEY
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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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7590 06/10/2002

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EXAMINER

WOODWARD, ANA LUCRECIA

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DATE MAILED: 06/10/2002

remail

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Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/12/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-68 is/are pending in the application.
- Of the above claim(s) 4, 13, 21, 27, 34, 35, 37, 44, 46-50, 53, 55, 60-68 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 5-9, 11, 12, 14-20, 22-26, 28-33, 36, 38, 43, 45, 51, 52, 54, 56-59 is/are rejected.
- ☒ Claim(s) 10 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I with polyethylene terephthalate, ethylene vinyl acetate copolymer, MDI and dilaurate as the ultimate species of first polymer, secondary polymer, compound and catalyst in Paper No. 3 and the subsequent telephonic conversation in April 2002 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 4, 13, 21, 27, 34, 35, 37, 44, 46-50, 53, 55 and 60-68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species or group, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 3.

Claim Rejections - 35 USC § 112

3. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite in that it is unclear how the MDI can be definitive of the epoxy compound.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5-8, 12, 16-20, 23, 25, 26, 28, 29, 32, 33, 36, 41-43, 45, 51, 54, 56 and 58 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,136,398 (Willett et al).

Willett et al disclose a curable composition formed by melt mixing 10 to 70 weight percent of a curable epoxy resin, an effective amount of a curative for the epoxy resin, 0.01 to 10 weight percent of a photocatalyst, 10-85 weight percent of a thermoplastic ethylene-vinyl acetate copolymer and 5 to 60 weight percent of a thermoplastic polyester resin. See abstract, column 4, line 56, column 7, lines 43-45, column 12, lines 11-35 and examples. The curative can be a photocatalyst or thermal curing agent.

As presently recited, the above-rejected claims read on the composition of the reference. With respect to applicants' product claims 6, 7 and 12, while they recite process limitations, it is the patentability of the product which must be established. It is well settled that the evaluation of product-by-process claims is based on the product rather than on the process steps. *In re Thorpe*, 227 USPQ 964. Thus, once the examiner has established a prima facie case of obviousness, the

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burden shifts to applicants to provide objective evidence that the claimed polyurethane oligomer is not the same as or obvious from that of the product of the prior art.

Claim Rejections - 35 USC § 103

7. Claims 9, 11, 14, 22, 30, 38-40, 52, 57 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,136,398 (Willett et al) described hereinabove.

With respect to claims 9 and 30, it is maintained that polyethylene terephthalate, while not expressly exemplified by the reference, clearly constitutes an obvious species of polyester from the general disclosure of the reference. In this regard, attention is directed to column 9, lines 45 and 56.

As to claim 14, it is maintained that it would have been obvious to have compounded the photocatalyst with one of the polymers in advance of blending because the reference clearly states that the components may be added sequentially in any order with the reasonable expectation of success (column 12, lines 23-25).

As to the further addition of additives, e.g., stabilizer, such are clearly disclosed at column 11, line 64 as optional adjuvants.

As to claims 38-40, attention is directed to the urea component listed at column 8, line 28, whose usage would fulfill the requirement of a urea "catalyst" as set forth in applicants' claims.

8. Claims 1-3, 5-8, 12, 14-20, 22-26, 28, 29, 31-33, 36, 38-43, 45, 51, 52, 54 and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,250,607 (Comert et al).

Comert et al disclose an interpenetrating polymer system prepared from a mixture of a moisture-cured prepolymer component and an elastomeric component, which is non-reactive

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with the prepolymer component. A preferred prepolymer component is prepared by reaction of a polyester diol (which reads on either of applicants' claimed first or secondary polymers) and a diisocyanate (which reads on applicants' claimed isocyanate compound) (column 4, lines 20-66). The elastomeric component reads on either of applicants' claimed first or secondary polymers and includes ethylene vinyl acetate copolymer (column 2, lines 59-60). Additionally, catalysts, stabilizers and other additives may be further incorporated into the composition (column 5, lines 3-10). The components are intimately blended and is extruded or molded.

In essence, the disclosure of the reference differs from the claimed invention in not expressly exemplifying an embodiment which includes a catalyst. In this regard, it is maintained that it would have been obvious to one having ordinary skill in the art to have formulated a composition containing a catalyst for its expected additive effect absent evidence of unusual or unexpected results. This is because the reference clearly discloses catalysts as suitable additives for the composition. As to the specific species of the various components preferred by applicants, it is maintained that such are obvious species from the corresponding generic disclosure of the reference. As to claim 14, it is maintained that it would have been obvious to have pre-compounded the catalyst with the reasonable expectation of success because no difference in final product is seen between a simultaneous or sequential addition of said component.

Allowable Subject Matter

9. Applicants' elected group embodiment comprising an interpenetrating network composition comprising polyethylene terephthalate, ethylene vinyl acetate copolymer, MDI and

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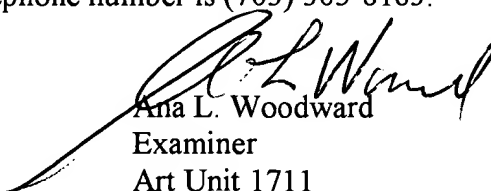
dilaurate is deemed allowable over the prior art of record. The references of record do not teach or render obvious this particular combination of ingredients.

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (703) 308-2401. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8183.



Ana L. Woodward
Examiner
Art Unit 1711

AW
June 6, 2002